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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

: **ATTN: BOX RCE**

Mitsuaki OSHIMA et al.

: Docket No. 2000_1422

Serial No. 09/686,466

: Group Art Unit 2634

Filed October 12, 2000

: Examiner A. Le

COMMUNICATION SYSTEM

: **Confirmation No. 3379**

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Technology Center 2600

PRELIMINARY REMARKS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

Sir:

These preliminary remarks are filed concurrently with a Request for Continued Examination.

In the Advisory Action mailed July 23, 2003, the Examiner indicated that the Information Disclosure Statement filed December 31, 2002 fails to include the petition after final rejection. The references cited in the Information Disclosure Statement of December 31, 2002 are resubmitted herein in a new Information Disclosure Statement. Further, it is noted that the Final Office Action mailed December 30, 2002 crossed in the mail with the Information Disclosure Statement filed December 31, 2002. Thus, the undersigned did not receive the Office Action of December 30, 2002 until January 2, 2003. However, in order to expedite the matter, and as mentioned above, the references from the Information Disclosure Statement originally filed December 31, 2002 are resubmitted herewith in a new Information Disclosure Statement concurrently with the filing of the Request for Continued Examination.

As also noted on the Request for Continued Examination transmittal form, Patentees request that the Amendment of June 30, 2003 be entered. The Amendment of June 30, 2003 includes a substitute specification and abstract. However, the Advisory Action issued July 23, 2003 fails to indicate whether or not the Amendment of June 30, 2003 has been entered. Entry of the Amendment is hereby requested.

In the Advisory Action, the Examiner indicates that the reply filed on June 30, 2003 is not fully responsive to the prior Office Action because Patentees did not submit a supplemental reissue oath/declaration. Patentees request that the Examiner not assert that a reply is "not fully responsive" for failing to include a supplemental reissue Oath/Declaration because, as indicated clearly in the MPEP § 1444 (see the section spanning pages 1400-45 and 1400-46),

"A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 C.F.R. 1.175(b)(1)."

Thus, the MPEP clearly sets forth that Patentees should not file a supplemental oath/declaration until the case is in condition for allowance. Thus, if a reply to an office action is filed by Patentees and includes a traversal of an outstanding rejection, or some amendment to the application, then the application cannot be said to be "in condition for allowance". Thus, in the present situation, the reply of June 30, 2003 included amendments to the application as well as arguments concerning rejections of claims. In the Advisory Action, the Examiner indicated that the reply has overcome the rejections. Thus, it was not until the Examiner's determination as indicated in the Advisory Action of July 23, 2003, that the application could possibly have been said to be in condition for allowance. Thus, the reply of June 30, 2003 should not be considered "nonresponsive" for failing to include a supplemental reissue oath or declaration that the office itself suggests should not be filed until the case is in condition for allowance. Further, Patentees submit that the proper course of action for the PTO under such circumstances is to issue an Office Action under Ex Parte Quayle indicating that the supplemental reissue oath/declaration remains as a formal requirement but that the application is otherwise in condition for allowance.

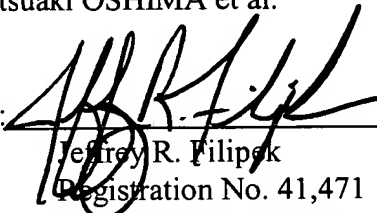
Along with the presently filed Request for Continued Examination, Patentees also submit herewith an Information Disclosure Statement citing several references. Thus, in keeping with the suggestion of the PTO, Patentees have not filed a supplemental reissue oath/declaration herein because the application is not yet in condition for allowance since the Examiner has not yet considered all of the references in the enclosed Information Disclosure Statement.

It is, however, submitted that the claims of the present application are allowable over all of the prior art of record in the application. The Examiner is invited to contact the undersigned attorney by telephone should there be any issues remaining.

Respectfully submitted,

Mitsuaki OSHIMA et al.

By:


Jeffrey R. Filipak
Registration No. 41,471
Attorney for Patentees

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Technology Center 2600

JRF/fs
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
September 2, 2003